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Patent
Attorney Docket No. ITW7510.027

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Dennis R. Sigl
Serial No. : 10/065,773
Filed : November 18, 2002
For : Inductor Assembly
Group Art No. : 2832
Examiner : Nguyen, T.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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RESPONSE TO 2-12-2004 RESTRICTION REQUIREMENT

Dear Sir:

Responsive to the Restriction Requirement mailed February 12, 2004, please enter the following election with traverse and consider the following comments for rejoinder.

Dennis R. Sigl

S/N: 10/065,773

ELECTION

Applicants elects, with traverse, what the Examiner has characterized as "Invention I", deemed drawn to a bobbin structure, and corresponding to claims 1-8.

REMARKS

The Examiner has identified three 'inventions' in the pending claims. The Examiner's classification of the 'inventions' include Group I consisting of claims 1-8 drawn to a bobbin structure and classified by the Examiner in class 336, subclass 198, Group II consisting of claims 9-15 drawn to an inductor assembly and classified by the Examiner in class 336, subclass 210, and Group III consisting of claims 16-20, drawn to a kit assembly and classified by the Examiner in class 219, subclass 672.

The Examiner states that "[i]nventions [II] and [I, III] are related as subcombinations disclosed as usable together in a single combination." The Examiner further states that:

[t]he subcombinations are distinct from each other if they are shown to be separately useable. In the instant case, invention [II] has separate utility such as the inductor assembly not using the bobbin structure of [I]; invention [III] has separate utility such as the kit assembly not using the inductor assembly of [II]. See MPEP §806.05(d).

The Examiner's classifications of the "Inventions" of the claims of the present invention evidence the close interrelation of what is called for in each of the groups. Applicant does not believe that the groupings of the claims include independent "inventions" and the Examiners' labeling of such is improper. As such, hereinafter, what the Examiner has termed as "inventions" are referred to as claim "Groups". The Examiner has classified Groups I and II into class 336 (titled: inductor assembly) and Group I into subclass 198 (titled: preformed insulation between coil and core) and Group II into subclass 210 (titled: with core clamps, wedges, or fasteners). Claim 6, included in the Examiner's Group I, calls for the bobbin to have a protrusion configured to engage a spring clip for securing a pair of ferrite cores to a molded body. As such, a complete examination of all that is disclosed in Group I, which includes claim 6, would necessarily have to include a search of the art associated with Group II. Additionally, even though the Examiner has classified Group III under class 219 (titled: electric heating) and subclass 672 (titled: specific inductor configuration) there is nothing in the body of claim 16 to limit the content of that claim to electric heating. The preamble of claim 16, in its entirety, calls for, in part, "a kit for retrofitting an inductor assembly of a welding-type device, the kit comprising: a molded bobbin"

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As such, a thorough examination of the claims of Group III would necessarily have to include a search of the classes and subclasses into which the Examiner has classified Groups I and II. In electing Group I, the broadest grouping of claims, the Examiner must search every class cited since that which is called for in claim 1 is a feature of each claim set. Restriction of the claims would result in the same search being conducted for each of the claim groups. This alone is sufficient to merit the examination of all of the claims.

Additionally, claim 1 calls for, in part, a bobbin having a molded body with a single flange to maintain a uniform gap between a pair of ferrite cores. Claim 9 calls for, in part, a plastic bobbin having an embossed flange to maintain a constant gap between a pair of ferrite cores. Claim 16 calls for, in part, a molded bobbin having a flange configured to maintain a uniform separation between a pair of ferrite cores. Applicant believes that if the Examiner examined the body of the claims, beyond the preamble, the interrelationship of the claims would be apparent. That is, each of the claim sets, regardless of which classification the Examiner applies, includes a significant portion of that which is called for in claim 1. As MPEP §806.05(d) cautions, "[c]are should always be exercised in this situation to determine if the several subcombinations are generically claimed. See MPEP §806.04(b)" MPEP §806.05(d) further states that "[w]here subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required." MPEP §806.05(d) (Emphasis added).

The fact that a majority of the subject matter of claim 1 appears in some form in both claims 9 and 16 indicates that claims 1, 9, and 16 are not only related as combination/subcombination, as suggested by the Examiner, but are also related as genus/species with the genus being the inductor assemblies of claims 9 and 16 and the species between the genus invention of the bobbin assembly of claim 1. MPEP §804.04(b) states that "two different subcombinations usable with each other may each be a species of some common generic invention." MPEP §806.04(d) further states that "[t]he general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which ... are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second and not the first." An examination of the claims, beyond a cursory review of the preambles, quickly elicits the interrelation of the claim groups. Simply put, removing the

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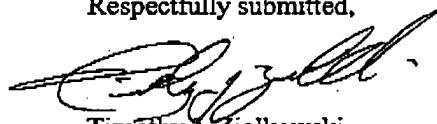
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clements of claims 9 and 16 that are generally coextensive with the elements of claim 1 shows the interrelationship of the claims. As such, the restriction is improper under §806.04(f).

Even further, MPEP §806.05(c) II, states the criteria for distinctness for combination/subcombination related claims: "[i]f there is no evidence that the combination AB_{sp} is patentable without the details of B_{sp}, restriction should not be required." As the claims of the application are related, claim 1 is representative of subcombination B_{sp}, directed to a bobbin structure, and claims 9 and 16 are related to claim 1, both as combinations AB_{sp} which define an inductor assembly. The relationship of claims 1, 9, and 16 is B_{sp}/AB_{sp}/AB_{sp}, respectively. An examination of the body of the claims, beyond the preamble, readily shows the interrelation of claim 1 to claim 9 and claim 16. Therefore, as stated in MPEP §806.05(c) II, restriction should not be required.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



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